



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

vt

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/052,001 11/07/97 CARR

R PS7194.024

PM82/0015
WILLIAM A BIRDWELL & ASSOCIATES
900 SOUTH WEST FIFTH AVENUE
SUITE 1925
PORTLAND OR 97204

EXAMINER

PICKARD, A

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 03/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/952,001

Applicant(s)
Carr

Examiner
Alison Pickard

Group Art Unit
3626



☒ Responsive to communication(s) filed on Dec 21, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 55-92 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 55-92 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3626

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 59, 66, 73, and 82 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims require a first, second, and third strip where the third strip is the smallest in diameter and the second strip is the largest. The claim also requires a spoke extending between the second and third strips. There is no support for this in the specification or the figures. The closest, Figure 11, includes the three rings but does not mention the claimed spoke extending from the second to the third strips.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 62, 69, 77, 78, 89, and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3626

The flanges were never positively claimed as part of the present invention. It appears applicant is assigning limitations of structure and dimensions to items not claimed. This is considered improper. If applicant wishes the flanges to be a part of the present invention, they should be positively set forth in the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claim 55 is rejected under 35 U.S.C. 102(e) as being anticipated by Carr, U. S. Patent No. 5,362,115.

Carr discloses a gasket for between flanges comprising a first strip 26 and a second strip 28 of sealing material and at least one spoke 30 extending between the first and second strips.

7. Claims 55 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Oberhuber.

Oberhuber discloses a gasket for between flanges comprising a first strip 20¹ and second strip 20² of sealing material and at least one spoke 25 extending between the first and second

Art Unit: 3626

strips wherein the remaining spaces are void. Regarding claim 59, the third strip would be 20', first strip 20², and the second strip 20³.

8. Claims 88-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubbard, U. S. Patent No. 1,942,704.

Hubbard discloses a gasket with a single ring 22(b) (see Fig. 5) with a concave notch or aperture at the outer periphery. Claiming the notch is for receiving a thickness gauge is considered intended use and is not given patentable weight.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 56-58, 85-87, 91, and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberhuber.

As described above, Oberhuber discloses a gasket with first and second strips. The strips are designed with a groove/notch or concavity 22 at the inner periphery and a convexity or rib 24 at the outer periphery to facilitate the attachment of the spokes 25. (See page 2, lines 60-83.) The complimentary shapes (convex/concave) that allow for the rings to be assembled. Changing the location of the concavity to the outer periphery and the convexity to the inner periphery is considered a design choice well within the skill of the art. Therefore, it would have been

Art Unit: 3626

obvious for one of ordinary skill in the art at the time the invention was made to reverse the locations of the concavity and convexity as a matter of choice in design. Claiming the notch is for receiving a thickness gauge is considered intended use and is not given patentable weight. Regarding claims 85-87, Oberhuber does not include a second strip with an outer periphery that is square. Making the second strip square is considered a design choice. Applicant has not stated that using a square shape solves any stated problem or is for any particular purpose and it appears that a circular shape would perform equally as well. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the gasket of Oberhuber by using a square shaped second strip as a matter of choice in design.

11. Claims 60-62, 67-69, and 73-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of Smith, U. S. Patent No. 4,002,344.

As described above, Carr discloses a gasket with first and second strips and an inner spoke. Carr does not include either an open or closed alignment spoke. Smith teaches the use of an open alignment spoke 46 and a closed alignment spoke 51 which extend outwardly from an outer strip of a gasket. The inner alignment spoke defines a concavity 48 and centering shelf 49. The closed alignment spoke 51, has an aperture for a bolt and a tab portion 56 with identification data 57. The alignment spokes allow for proper centering of the gasket relative to a variety of flange sizes. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the gasket of Carr with the alignment spokes of Smith to allow the proper centering of the gasket against any size flange to ensure the best fit and seal.

Art Unit: 3626

12. Claims 60, 63-67, 70-72, 76, and 79-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberhuber in view of Smith.

As described above, Oberhuber discloses a gasket with first and second strips and an inner spoke. Oberhuber does not include either an open or closed alignment spoke. Smith teaches the use of an open alignment spoke 46 and a closed alignment spoke 51 which extend outwardly from an outer strip of a gasket. The inner alignment spoke defines a concavity 48 and centering shelf 49. The closed alignment spoke 51, has an aperture for a bolt and a tab portion 56 with identification data 57. The alignment spokes allow for proper centering of the gasket relative to a variety of flange sizes. Oberhuber also does not include the concavity or notch on the outer periphery of the second ring, but rather on the inner periphery. Changing the location of the concavity to the outer periphery and the convexity to the inner periphery is considered a design choice well within the skill of the art. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the gasket of Oberhuber with the alignment spokes of Smith to allow the proper centering of the gasket against any size flange to ensure the best fit and seal and to reverse the locations of the concavity and convexity as a matter of choice in design.

Response to Arguments

13. Applicant's arguments filed 12-21-99 have been fully considered but they are not persuasive.

Art Unit: 3626

The prior art discloses applicant's invention as claimed. Carr and Oberhuber both disclose a gasket with first and second strips and a spoke and voids in between. Applicant's argument regarding the concave notch adapted to receive a thickness gauge is not persuasive. The thickness gauge is not a part of the claimed invention and is therefore considered intended use. The prior art includes all of the structure claimed. No further limitations have been provided which would distinguish Oberhuber's notch from applicant's.


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3626

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison Pickard whose telephone number is (703) 305-0882.


Anthony Knight
Supervising Patent Examiner
Group 6600

ap

March 12, 2000